

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants: John M. Packes, Jr., Jay S. Walker, Daniele E. Tedesco, Stephen C. Tulley
and Keith Bemmer

Application No.: 09/409,041

Filed: September 29, 1999

Title: SYSTEM AND METHODS TO PROVIDE A PRODUCT TO A
CUSTOMER BEFORE A FINAL TRANSACTION TERM VALUE IS
ESTABLISHED

Attorney Docket No.: 99-030

Group Art Unit: 3627

Examiner: Cuff, Michael

REPLY BRIEF

Appellants hereby reply to the Examiner's Answer mailed May 19, 2006.

REMARKS

GROUP I: claims **1, 2, 4, 5, 12 – 16, 18 – 20, 22 – 27, 29, 31 – 35, 38 – 42, 53 and 55** (NOTE: the Appeal Brief inadvertently referred to claim **56** as being part of GROUP I as well as GROUP II. However, as is clear from the limitation of claim **56**, claim **56** is intended to be part of GROUP II).

- Claim limitation argued in Appeal Brief:

wherein the customer is to provide payment of a final price of the product at the end of the period of time, the final price being either the default price or an override price that is received before the end of the period of time

Appellants respectfully submit that the Examiner still has not shown how the combination of references results in the claimed embodiment.

Neither Reuhl nor Bloomberg describe a system in which a customer enters into an agreement regarding a product and is allowed to take possession of the product without providing payment therefore, all before a final price for the product is determined. In Reuhl a customer take possession of a product before paying for the product, but the final price of the product is already determined at the time of sale. In Bloomberg a customer may get a rebate for a product after taking possession of it, but the customer pays for the product up front and thus has already provided the payment when the rebates are determined. Thus, putting Reuhl and Bloomberg together, at most, results in a system in which a customer takes possession of a product before paying for the product, then pays for the product and, *after* providing the payment, may receive rebates. The combination of Reuhl and Bloomberg does not result in all of the limitations of the embodiment claimed in representative claim **1**.

In the claimed embodiments a customer is charged one of two possible prices for a product at the end of a period of time after a customer takes possession of the product. The price is one of two possible prices: a default price or an override price. As claimed, it is determined at this period of time which of the two possible prices to charge a customer. Neither Reuhl nor Bloomberg, alone or in combination, teach such a system. In Reuhl the customer is charged a price for a product after a period of time from taking possession of the product. However, there is no determination of which of two possible prices to charge the customer, since the price is established at the time the customer takes possession of the product. In Bloomberg there is a similar lack of disclosure of determining which of two prices to charge a customer at the end of a period of time after the customer takes possession of the product. In Bloomberg the customer pays for the product at the time of taking possession of it. The customer may receive a rebate after paying for the product, but this does not detract from the fact that the customer has already provided payment of a price for the product. Again, the combination of Reuhl and Bloomberg, at most, would result in a system in which a customer does not pay for a product when taking possession of the product, then pays for the product at some point after taking possession of the product (the price having already been established). After providing payment for the product, the customer may receive a rebate. In other words, irrespective of when the customer provides payment for the product (whether it be at the time of taking possession of the product, as in Bloomberg, or at some point after taking possession of the product, as in Reuhl), there is absolutely no description in either reference of determining which of two prices to charge a customer, much less of determining which of two prices to charge a customer at the end of a period of time after the customer has taken possession of the product.

Appellants respectfully note that the diagram provided by the Examiner on page 4 of the Examiner's Answer, while illustrating that in the Reuhl system the payment is provided (i.e., the customer is charged a price) at the end of a period of time, fails to show when payment is provided by the customer in the Bloomberg system. If the diagram were clarified to show the timing of the customer's payment in the Bloomberg system, it would show that the customer in Bloomberg pays the price for the product at the time of taking possession of the product. Thus, there is no determination of which of two prices to charge a customer, as is claimed.

Appellants further respectfully note, as evidenced by the claim limitation map provided by the Examiner on page 3 of the Examiner's Answer, that the Examiner appears to be inappropriately examining the claim piece-meal, rather than as a whole as is required.

With respect to the Examiner's comments regarding the motivation to combine the references (on page 5 of the Examiner's Answer), Appellants respectfully note that the part of the specification being relied upon by the Examiner at most acknowledges that a particular transaction may involve multiple terms (e.g., interest or finance rate, payment schedule, duration of warranties). This is not equivalent to combining different terms of different incentive programs. Further, even if the Examiner did provide support for the proposition that combining different terms of different incentive programs were known, the Examiner has still failed to show that combining the particular terms at issue in the claimed embodiments would have been obvious to a person of ordinary skill in the art at the time of the claimed invention.

GROUP II: claims 3, 17 and 56

Claim limitation argued in Appeal Brief:

wherein said receiving a first override price comprises receiving the first override price from the customer

Appellants respectfully note that while Bloomberg does describe, at column 1, lines 31 – 32, that in some systems a customer may provide an advertisement of a lower price in order to receive a rebate, Bloomberg immediately thereafter (col. 1, lines 32 – 51) describes a multitude of draw-backs to such a practice. Accordingly, a person of ordinary skill in the art, upon reading Bloomberg, would have been discouraged from formulating a system in which a customer provides an indication of a lower price for a product after having purchased the product. In other words, Bloomberg teaches away from a practice of receiving an indication of a lower price for a product from a customer, whether the indication were to be received before or after a customer pays for the product.

GROUP III: claim 21

Claim limitation argued in Appeal Brief:

wherein confirming the first override price comprises contacting the competing product provider to verify the first override price

The Examiner provides (at page 3, section 10 of the Examiner's Answer) the unsupported conclusion that scanning advertisements of competitors to determine a price for a product is equivalent to contacting the competitor in order to verify the price. This is not a viable or logical conclusion.

First, what would be verified by scanning the advertisement of a competitor? Verification or confirmation presupposes that a piece of data has already been received. If no piece of data were to have been already received, then what is

being *confirmed* or *verified*? The information gleaned by scanning an advertisement of a competitor in Bloomberg is a first receipt of the information, not a verification or confirmation of the information. Accordingly, Bloomberg fails to describe verifying or confirming a price.

Second, the Examiner has provided no reasoning or evidence that scanning an advertisement of a competitor (for whatever purpose) would have been understood by a person of ordinary skill in the art as equivalent to contacting the competitor.

GROUP IV: claim 54

Claim limitation argued in Appeal Brief:

wherein said receiving, determining and charging are performed by a credit card issuer

The Examiner, at page 3, section 10 of the Examiner's Answer, has provided support for the rejection of this claim by citing Appellants' specification, page 2, line 11. As a preliminary matter, Appellants note that this is a new grounds of rejection for this claim. Further, the Examiner has still failed to make a *prima facie* case of anticipation or obviousness for this claim because the cited portion of the specification merely states that "some credit card issuers also provide price protection programs." However, nothing in the specification admits that the particular price protection program claimed (or any particular portion thereof) was old or well known. In other words, the Examiner has not addressed the limitations of claim 54 and has thus utterly failed to show that it was old or well known, or even obvious, for a credit card issuer to perform the steps of *receiving, determining and charging* as claimed.

CONCLUSION

Appellants respectfully request that the Examiner's rejections be reversed for the reasons specified in this Reply Brief and in the Resubmitted Appeal Brief.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Magdalena M. Fincham using the information provided below.

Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

July 19, 2006
Date

/Magdalena M. Fincham, 46,085/
Magdalena M. Fincham
Attorney for Appellants
Registration No. 46,085
mfincham@walkerdigital.com
(203) 461 - 7041/voice
(203) 461-73007018 /fax